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Applicants: Stewart et al.	Examiner: Campbell, Joshua D.
Title: System, method and recordable medium for printing services over a network and graphical user interface	Docket No.: MIME-0003

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BRIEF OF APPELLANTS

Sir:

This paper is being filed as part of an appeal from the Final Office Action dated 22 June 2010 rejecting claims 12-16, 20-27, and 31-43. This Brief is accompanied by the requisite fee set forth in 37 C.F.R. 1.17(c).

REAL PARTY IN INTEREST

Mimeo.com, Inc. is the real party in interest.

RELATED APPEALS AND INTERFERENCES

This application was previously appealed to the Board of Patent Appeals and Interferences (Appeal 2007-3345) and a decision was rendered by the Board on June 16, 2008. An appeal for a related application, U.S. Application No. 10/668,701, is currently pending with the Board of Patent Appeals and Interferences (Appeal 2010-009627).

STATUS OF CLAIMS

As filed, this case included claims 1-11. Subsequently, claims 1-11 were canceled and claims 12-33 were added. In other amendments, claims 17-19 and 28-30 were canceled; and claims 34-43 were added. Claims 12-16, 20-27, and 31-43 are pending. Claims 12-16, 20-27, and 31-43 stand rejected and form the basis of this appeal.

STATUS OF AMENDMENTS

No amendment to the claims or response has been submitted subsequent to the 22 June 2010 Final Office Action.

SUMMARY OF CLAIMED SUBJECT MATTER

The present invention provides a solution for previewing and/or printing a document over a network.

Claim 12 claims a method of previewing a document over a network (see, e.g., p. 8, lines 6-10; FIG. 7, 620), the method comprising: providing system software for use on a client (see, e.g., p. 10, lines 13-16; FIG. 13), wherein the system software allows a user of the client to use an application configured to at least one of: display or edit the document to request to remotely print the document (see, e.g., p. 22, line 19-p. 23, line 5; FIGS. 15A-C), and, in response to the request and without user-initiated interaction with a server, generates a print file on the client based on the document (see, e.g., p. 17, lines 12-14; FIG. 7, 605), transmits the print file from the client to the server in response to the generation of the print file (see, e.g., p. 17, lines 15-18; FIG. 7, 610),

and prompts the user to configure and preview a bound copy of the document using a browser in response to the transmission of the print file (see, e.g., p. 23, lines 12-14; FIG. 15J); obtaining the print file from the system software executing on the client on the server (see, e.g., p. 13, lines 8-12; p. 17, lines 15-18; FIG. 7, 610); and providing a configuration wizard for display in a browser on the client in response to a request from the client (see, e.g., p. 25, lines 3-12; FIGS. 17B-F).

Claim 20 claims a computer system comprising: a component configured to preview a document over a network (see, e.g., p. 8, lines 6-10; FIG. 2, 300) by performing a method comprising: providing system software for use on a client (see, e.g., p. 10, lines 13-16; FIG. 13), wherein the system software is configured to allow a user to request to remotely print the document (see, e.g., p. 22, line 19-p. 23, line 5; FIGS. 15A-C), and, in response to the request and without user-initiated interaction with a server, generate a print file on the client based on the document (see, e.g., p. 17, lines 12-14; FIG. 7, 605), transmit the print file from the client to the server in response to the generation of the print file (see, e.g., p. 17, lines 15-18; FIG. 7, 610), and prompt the user to configure and preview a bound copy of the document using a browser in response to the transmission of the print file (see, e.g., p. 23, lines 12-14; FIG. 15J), wherein the print file can be directly printed by a printer (see, e.g., p. 12, lines 15-17; FIG. 7, 605); obtaining the print file from the system software executing on the client and configuration information for the document on the server (see, e.g., p. 17, lines 10-19; FIG. 6, 320), wherein the configuration information defines finishing and binding options for a printed copy of the document (see, e.g., p. 17, lines 17-19; FIGS. 17B-F); generating a preview of a configured copy of the document based on the print file and

the configuration information on the server (see, e.g., p. 17, lines 17-19; FIGS. 17B-F); and providing the preview for display at the client (see, e.g., p. 17, lines 16-19; FIGS. 17B-F).

Claim 24 claims a computer system comprising: a component configured to print a document over a network (see, e.g., p. 16, line 17-p. 17, line 9; FIG. 6, 300) by performing a method comprising: providing system software for use on a client (see, e.g., p. 10, lines 13-16; FIG. 13), wherein the system software is configured to enable a user of an application configured to at least one of: display or edit the document to request generation of a print file based on the document using the application (see, e.g., p. 22, line 19-p. 23, line 5; FIGS. 15A-C), generate the print file on the client in response to the request without further user interaction (see, e.g., p. 17, lines 12-14; FIG. 7, 605), and transmit the print file from the client to a server in response to the generation of the print file without user-initiated interaction with the server (see, e.g., p. 17, lines 15-18; FIG. 7, 610); obtaining a print file from the system software executing on the client and configuration information for the document on the server (see, e.g., p. 17, lines 10-19; FIG. 6, 320), wherein the print file can be directly printed by a printer and the configuration information defines how to assemble a printed copy of the document (see, e.g., p. 17, lines 17-19; FIGS. 17B-F); generating a preview of a configured copy of the document based on the print file and the configuration information on the server (see, e.g., p. 17, lines 17-19; FIGS. 17B-F); and providing the preview for display at the client (see, e.g., p. 17, lines 16-19; FIGS. 17B-F).

Claim 31 claims a computer program product comprising a computer recordable medium having computer readable program code embodied therein for enabling a

computer system to print a document (see, e.g., p. 16, line 17-p. 17, line 9; FIG. 6, 300) by performing a method comprising: providing system software for use on a client (see, e.g., p. 10, lines 13-16; FIG. 13), wherein the system software allows a user of the client to use an application configured to at least one of: display or edit the document to request to remotely print the document (see, e.g., p. 22, line 19-p. 23, line 5; FIGS. 15A-C), and, in response to the request and without user-initiated interaction with a server, generates a print file on the client based on the document (see, e.g., p. 17, lines 12-14; FIG. 7, 605), transmits the print file from the client to the server in response to the generation of the print file (see, e.g., p. 17, lines 15-18; FIG. 7, 610), and prompts the user to configure and preview a bound copy of the document using a browser in response to the transmission of the print file (see, e.g., p. 23, lines 12-14; FIG. 15J); obtaining a print file from the system software executing on the client and configuration information communicated over a network (see, e.g., p. 13, lines 8-12; p. 17, lines 15-18; FIG. 7, 610), wherein the print file is based on the document and the print file can be directly printed by a printer and the configuration information defines how to assemble a printed copy of the document (see, e.g., p. 17, lines 17-19; FIGS. 17B-F); and printing a copy of the document based on the print file and the configuration information (see, e.g., p. 18, lines 1-5; FIG. 7, 640-665).

Claim 37 claims a method of printing a document over a network (see, e.g., p. 8, lines 6-10; FIG. 7), the method comprising: obtaining document information for a document on a server from system software executing on a client (see, e.g., p. 18, lines 18-21; FIG. 9, 510), wherein the system software is configured to enable a user of the client to use an application to request generation of a print file based on the document

using the application (see, e.g., p. 22, line 19-p. 23, line 5; FIGS. 15A-C), generate the print file on the client in response to the request without further user interaction (see, e.g., p. 17, lines 12-14; FIG. 7, 605), and initiate transmitting the print file from the client to the server in response to the generation of the print file and without user-initiated interaction with the server (see, e.g., p. 17, lines 15-18; FIG. 7, 610); generating a unique identifier for the document on the server and transmitting the unique identifier for use by the system software in response to obtaining the document information (see, e.g., p. 19, lines 15-21; FIG. 9, 526); obtaining the print file on the server from the system software executing on the client subsequent to obtaining the document information (see, e.g., p. 19, line 21-p. 20, line 2; FIG. 9, 532); storing the print file using the unique identifier (see, e.g., p. 20, lines 2-4; FIG. 9, 542); obtaining a request for a configuration graphical user interface from the client subsequent to obtaining the print file (see, e.g., p. 23, lines 12-18; FIGS. 15J, 16A); and providing the configuration graphical user interface for display in a browser on the client in response to the request (see, e.g., p. 23, line 18-p. 24, line 3; FIGS. 15K, 16A, 1605, and 17B-F).

Claim 41 claims a method of generating a graphical user interface comprising: generating content for a display area of the graphical user interface (see, e.g., page 21, lines 1-10; FIG. 10, 1045), wherein the display area concurrently includes: a preview area for displaying a preview of a configured copy of a document (see, e.g., page 25, lines 3-10; FIGS. 17B-F), wherein the preview is based on a print file and configuration information for the document (see, e.g., page 25, lines 3-10; FIGS. 17B-F), wherein the configuration information includes at least one printing option and defines how to assemble a printed copy of the document (see, e.g., page 25, lines 3-10; FIGS. 17B-F);

a navigation area that enables a user to select a portion of the configured copy of the document displayed in the preview area (see, e.g., page 25, lines 3-10; FIGS. 17B-F); an estimate area for displaying a price estimate for printing and assembling the configured copy (see, e.g., page 25, lines 3-10; FIGS. 17B-F), wherein the price estimate is based on the print file and the configuration information (see, e.g., page 25, lines 3-10; FIGS. 17B-F); and a configuration area that enables the user to alter the configuration information (see, e.g., page 25, lines 3-10; FIGS. 17B-F), wherein the preview area and the estimate area are automatically updated based on the altered configuration information (see, e.g., page 25, lines 3-10; FIGS. 17B-F).

Claim 42 claims a computer program product comprising a computer recordable storage medium having computer readable program code embodied therein for enabling a computer system to preview a document by performing a method comprising: generating a print file on a client based on the document in response to a request received from an application (see, e.g., p. 17, lines 12-14; FIG. 7, 605), wherein the print file can be directly printed by a printer (see, e.g., p. 12, lines 15-17; FIG. 7, 605); transmitting the print file from the client to a server in response to the generation of the print file without user-initiated interaction with the server (see, e.g., p. 17, lines 15-18; FIG. 7, 610); and prompting the user to configure and preview a bound copy of the document using a browser in response to the transmission of the print file (see, e.g., p. 23, lines 12-14; FIG. 15J).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

I.   Rejection of claim 41 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,134,568 (Tonkin).

II.   Rejection of claims 37, 38, and 40 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,615,234 (Adamske).

III.   Rejection of claims 12-16, 20-27, 31-36, 39, and 42 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Adamske in view of Tonkin.

IV.   Rejection of claim 43 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Adamske in view of Tonkin further in view of Konica Minolta, "QMS Printing Notes for Windows Applications," published June 20, 1995 (KM).

ARGUMENT

I.   Rejection of claim 41 under 35 U.S.C. § 102(e)

In order to maintain a proper rejection under 35 U.S.C. § 102, the Examiner must show that a single reference discloses each feature of the claimed invention. In particular, the Examiner must show that "[t]he identical invention... [is] shown in as complete detail as is contained in the... claim" to maintain a rejection under 35 U.S.C. § 102. See, e.g., MPEP § 2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). To this extent, in order to anticipate the claimed invention, the reference must "disclose[] within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim." *Net MoneyIN, Inc. v. VeriSign, Inc.*, No. 2007-1565, pp. 17-18 (Fed. Cir. 2008). Appellants respectfully submit that the Examiner fails to present such a showing.

For example, Appellants respectfully submit that the Examiner fails to show that Tonkin discloses generating content for a display area that concurrently includes a preview area, a navigation area, an estimate area, and a configuration area as claimed therein. In support of the rejection, the Examiner cites: col. 7, lines 11-46 of Tonkin, which discusses a main document editing window shown in FIG. 5B of Tonkin; and col. 12, line 23-col. 13, line 51 of Tonkin, which discusses a viewing window shown in FIGS. 8A-E, and a window for displaying document data shown in FIG. 9 of Tonkin. To this extent, the Examiner cites the use of three distinct windows in Tonkin as allegedly disclosing the display area of claim 41.

In contrast, the invention of claim 41 generates content for a display area of a graphical user interface that concurrently includes a preview area, a navigation area, an estimate area, and a configuration area. Tonkin's three distinct windows do not constitute a display area of a graphical user interface that concurrently includes the four areas of claim 41.

In response to Appellants' arguments, the Examiner alleges that "[b]y definition windows are a part of a graphical user interface that encompass a portion of the screen that allow many different items to be displayed on the screen concurrently." Final Office Action, p. 19. To this extent, the Examiner apparently recognizes that the rejection relies on multiple windows, but alleges that these windows can be arranged by a user to be simultaneously visible.

Initially, Appellants note that Tonkin does not include any teaching indicating the windows are arranged in such a manner as to be concurrently visible, nor does Tonkin include any teaching that such an arrangement would be desirable. To this extent, the Examiner does not cite to any portion of Tonkin as including such a teaching, instead relying exclusively on the proffered definition of window.

However, the Examiner ignores express teachings of Tonkin that indicate that the various windows are presented in series, rather than concurrently.

Initially, Tonkin describes various windows that are preferably web pages. See, e.g., Tonkin, col. 6, lines 41-44; 59-63. As such, these web pages are typically displayed in a browser, a single page at a time. To this extent, Tonkin does not disclose use of multiple browsers concurrently or concurrent display of the web pages in a browser.

Furthermore, Tonkin describes FIG. 5B as being a part of a group of windows for "creating a document and inputting document specification for the document," which can be presented during step 254 of the flow diagram shown in FIG. 4 of Tonkin. Tonkin, col. 6, line 41-col. 7, line 27. Each of this group of windows is intended to be displayed in succession. See, e.g., Tonkin, col. 7, lines 8-10 and lines 66-67 describing navigation to/from FIG. 5B.

Additionally, Tonkin only describes image data for the document being generated and displayed (using the windows shown in FIGS. 8A-E) after the user has navigated away from the window shown in FIG. 5B (and also FIG. 5F). See, e.g., Tonkin, FIG. 4, steps 260, 262; col. 9, lines 38-42 and col. 12, lines 23-26. While the user may request to edit the document specification, Tonkin describes this being done "after having viewed the document images." Tonkin, col. 13, lines 13-16.

Still further, Tonkin only describes the window shown in FIG. 9 as being displayed "upon receipt of the order." Tonkin, col. 13, lines 26-31. To this extent, the windows shown in FIGS. 5B and 8A-E logically would not be concurrently presented to the user since these windows are only used to enable the user to define aspects of the document corresponding to the order, prior to the order being placed. See, e.g., Tonkin, FIG. 4, which ends with the order request being transmitted. Concurrent display of these windows with the window shown in FIG. 9 would present confusion to the user, since he/she would not be able to utilize the functionality provided by the window shown in FIG. 5B since the order has already been placed.

In light of the above, Appellants respectfully submit that the Examiner fails to present a *prima facie* showing that Tonkin discloses not only all of the limitations

claimed, but also all of the limitations arranged or combined in the same way as recited in claim 41. As a result, Appellants respectfully request reversal of the rejection of claim 41 as allegedly being anticipated by Tonkin.

II.   Rejection of claims 37, 38, and 40 under 35 U.S.C. § 103(a)

A. Claim 37

With respect to claim 37, Appellants respectfully submit that the Examiner fails to show that the proposed combination of the two embodiments of Adamske teaches or suggests obtaining document information for a document on a server from system software executing on a client, where the system software is configured to enable a user of the client to use an application to request generation of a print file based on the document using the application, generate the print file on the client in response to the request without further user interaction, and initiate transmitting the print file to the server in response to the generation of the print file and without user-initiated interaction with the server as claimed therein.

In support of the rejection, the Examiner apparently cites to col. 5, line 64-col. 7, line 15 of Adamske as allegedly teaching the system software of claim 37, and its interaction with the server. Adamske generally discusses two embodiments for a system and method for delivering an electronic document over a network.

In the first embodiment, discussed from column 4, line 61 through column 6, line 23 of Adamske, a user uploads an electronic document from a client computer to a web server using a web browser or email. Adamske, col. 5, lines 15-17. The web server routes the electronic document to an application translation server for conversion to a

portable printable format. Adamske, col. 5, lines 18-24. In order to perform the conversion, "the application translation program [on the application translation server] houses the variety of client applications that users use to create electronic documents." Adamske, col. 5, lines 19-21. The converted printable electronic document is then returned to the web server, where it is processed to create web-viewable print preview files. Adamske, col. 5, line 64-col. 6, line 3. The user can use the client-side web browser to preview the document. Adamske, col. 6, lines 12-15.

In the second embodiment, discussed from column 6, lines 24-57 of Adamske, "the client computer includes a print driver program... that is executable to convert the electronic document and provide the print preview capability prior to uploading to the web server." Adamske, col. 6, lines 34-38. In particular, the print driver program creates a metafile from the electronic document, which provides a viewable representation of how the document will look upon printing. Adamske, col. 6, lines 46-49. Subsequently, the user "sends this metafile to [the application] translation server through web server and the conversion into a printable (e.g., PostScript) version is performed as previously described." Adamske, col. 6, lines 49-52.

To this extent, contrary to both embodiments of Adamske, in which a user sends an electronic document (first embodiment) or a metafile (second embodiment) from his/her client computer to a web server, which subsequently routes the file to an application server for conversion into a printable version by the application translation server (see, e.g., Adamske, col. 5, lines 15-19; col. 6, lines 49-52), in claim 37, the system software is configured to generate the print file based on the document on the

client being used by the user in response to a request made by the user using an application.

Furthermore, contrary to both embodiments of Adamske, in which a web server receives the print file from the application server after having routed a file (electronic document or metafile) to the application server (Adamske, col. 5, lines 17-19 and 64-66; and col. 6, lines 50-54), in claim 37, the server obtains document information and the print file from system software executing on a client being used by a user. In this manner, the server in claim 37 does not need to receive and/or route the document or a derivative thereof (e.g., metafile discussed in Adamske), prior to receiving a print file generated based on the document.

Additionally, contrary to both embodiments of Adamske, in claim 37, the system software is configured to initiate transmitting the print file from the client to the server without user-initiated interaction with the server. In contrast, in the first embodiment of Adamske, the user expressly initiates interaction with the web server through the use of a standard web browser or using e-mail (first embodiment, Adamske, col. 5, lines 15-17). In the second embodiment of Adamske, the "user 10 sends this metafile to translation server 24 through web server 22." Adamske, col. 6, lines 49-51. When read in the context of Adamske's discussion of the first embodiment, and without the hindsight of Appellants' claimed invention, Adamske clearly intends for the user to send the metafile using a standard web browser or using e-mail in the second embodiment. In claim 37, the system software is configured to integrate use of the server to configure and/or print a document with the application being used by the user. In particular, the system software is configured to enable the user to use the application to generate a

request, which initiates the generation and transmission of a print file from the client to the server, while Adamske requires the user to utilize specialized software, such as a web browser or e-mail, to use the web server to configure and/or print a document.

Since neither of the embodiments of Adamske teaches or suggests any of the above-referenced features of claim 37, Appellants submit that the Examiner's proposed combination of the two embodiments of Adamske also necessarily fails to teach or suggest any of the above-referenced features.

Moreover, the Examiner fails to show that the proposed combination of the two embodiments of Adamske teaches or suggests generating a unique identifier for the document on the server and transmitting the unique identifier for use by the system software in response to obtaining the document information as in claim 37. In the rejection, the Examiner alleges that "a user uses software on a client device to generate a print file by requesting to generate it which is identified by a unique identifier (the file name) and uploads it to a server..." Final Office Action, p. 3. Appellants note that the file name discussed in Adamske is not generated on a server and transmitted for use by system software executing on a client in response to obtaining document information from the system software as in claim 37. To the contrary, in Adamske, the file name identifies the document uploaded from the client to the server using a standard web browser or using e-mail. Alternatively, the Examiner may be referring to the name of the print file. However, in both embodiments of Adamske, the print file is generated on an application translation server and provided to the web server. The name of the print file is never transmitted from any server for use by system software executing on a

client in response to obtaining document information from the system software as in claim 37.

In response to Appellants' previously presented arguments, the Examiner alleges, without citation to Adamske, that "the printable version of the file is created at the client." Final Office Action, p. 20. Appellants have addressed the factual inaccuracy of this statement above.

Additionally, the Examiner states that Appellants have made "no actual response to the BPAI's decision of this teaching to be true." Final Office Action, p. 20. Appellants note that the previous decision addressed a substantively different claim. In particular, in the decision, the BPAI "broadly but reasonably construe[d] a 'client' as a requester of services and a 'server' as a provider of services." Decision on Appeal, p. 10. Additionally, the BPAI stated that "Adamske's conversion program 18 teaches and/or suggests 'system software,' as claimed." *Id.* As found by the BPAI, the conversion program is included on the application translation server of Adamske. Decision on Appeal, p. 7, Findings of Fact 3. To this extent, in the previous decision, the BPAI interpreted the application translation server 24 of Adamske as allegedly corresponding to the client of the previously claimed invention.

Appellants' claim 37 includes several features that clearly differentiate the client described therein from the application translation server of Adamske. For example, the invention of claim 37 includes features indicating that the server: (a) obtains document information for a document from the system software executing *on the client*; (b) generates and transmits a unique identifier for use by the system software [executing *on the client*]; (b) obtains the print file from the system software executing *on the*

client; (c) obtains a request for a configuration graphical user interface *from the client* subsequent to obtaining the print file; and (d) provides the configuration graphical user interface for display in a browser *on the client* in response to the request. To this extent, the server receives document information, a print file, and a request for a configuration graphical user interface from the same client, and provides the client with a unique identifier and the configuration graphical user interface for display in a browser thereon. In light of these features, Appellants respectfully submit that the invention of claim 37 includes additional aspects with respect to the interaction between the client and the server that clearly overcome the BPAI's previous interpretation of the application translation server 24 of both embodiments of Adamske as allegedly corresponding to a previously claimed client.

In light of the above, Appellants respectfully request reversal of the rejections of claim 37, and claims 38, and 40, which depend therefrom, as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske.

B. Claim 40

With further respect to claim 40, Appellants respectfully submit that the Examiner fails to show that Adamske teaches or suggests installing the system software on the client, wherein the system software includes at least one print driver for generating the print file on the client and an upload manager for communicating the print file from the client to the server as claimed therein. As discussed above, in both embodiments of Adamske a print file is provided to a web server from an application translation server (Adamske, col. 5, lines 64-66; col. 6, lines 50-54). As also discussed above, claim 37

includes various interactions between the server and client that clearly distinguish the client of claim 37 from the application translation server of Adamske. To this extent, neither embodiment of Adamske discloses installing system software on a client that both generates a print file on the client and transmits the print file from the client to the server as part of a method that also includes the various interactions between the client and server of claim 37.

In light of the above, Appellants again respectfully request reversal of the rejection of claim 40 as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske.

III. Rejections of claims 12-16, 20-27, 31-36, 39, and 42 under 35 U.S.C. § 103(a)

A. Claim 12

With respect to claim 12, Appellants submit that the Examiner fails, *inter alia*, to show that the proposed combination of the two embodiments of Adamske and Tonkin teaches or suggests a method of previewing a document over a network that includes all the features claimed therein.

For example, Appellants submit that the Examiner fails to show that the proposed combination of the two embodiments of Adamske and Tonkin teaches providing system software for use on a client, which allows a user of the client to use an application configured to at least one of: display or edit the document to request to remotely print the document, and, in response to the request and without user-initiated interaction with a server, generates a print file on the client based on the document, transmits the print file from the client to the server in response to the generation of the print file, and

prompts the user to configure and preview a bound copy of the document using a browser in response to the transmission of the print file as in claim 12.

In support of the rejection, the Examiner cites to various portions of Adamske, which discuss the two embodiments for a system and method for delivering an electronic document over a network as discussed above, as allegedly teaching the system software of claim 12.

However, as discussed above, in both embodiments of Adamske: (a) the user must initiate interaction with the web server via a standard web browser or using e-mail (Adamske, col. 5, lines 15-17; col. 6, lines 49-51); and (b) the print file is generated on an application translation server after a document or a derivative thereof (e.g., metafile) is routed to it by a web server (Adamske, col. 5, lines 17-19 and 64-66; and col. 6, lines 50-54). To this extent, neither embodiment of Adamske provides system software that allows a user of a client to use an application configured to display and/or edit the document to request to remotely print the document, generates the print file on the client, and transmits the print file from the client to the server without user-initiated interaction with the server.

Additionally, the provided system software of claim 12 prompts the user to configure and preview a bound copy of the document using a browser in response to the transmission of the print file. In support of the rejection, the Examiner cites col. 6, line 58-col. 7, line 15 of Adamske as allegedly teaching this feature. This portion of Adamske describes options provided to the user in an operational screen 70 "[a]fter user 10 verifies the print preview." Adamske, col. 6, lines 58-59. Initially, Appellants submit that Adamske's description of options provided to the user after verification of the

print preview fails to teach or suggest prompting the user to configure and preview a bound copy of the document as in claim 12. In particular, it is not reasonable interpretation of Adamske that it discloses prompting a user to perform an operation (e.g., preview a bound copy) after the user has verified the result of the operation (verifying the print preview). Furthermore, Appellants note that the operational screen 70 is a web page provided by the web server, which likewise fails to teach or suggest, and arguably teaches against, the use of system software for use on a client to prompt the user of the client to configure and preview a bound copy of the document as in claim 12.

The Examiner proposes to combine the two embodiments of Adamske with the teachings of Tonkin. Tonkin provides a web page in which a user enters a source file that includes the content to be included in a document. Tonkin, FIG. 5B, ref. 312; col. 7, lines 13-17. The source file can be a PDF file or another format, which can be first converted to PDF format. Tonkin, col. 7, line 17-27. Subsequently, image(s) of the document are generated and displayed. Tonkin, col. 12, lines 23-34.

To this extent, Tonkin fails to address the deficiencies of both embodiments of Adamske discussed above with respect to the various features of the system software provided for use on a client of claim 12. In particular, similar to both embodiments of Adamske, Tonkin teaches that the user uses a web page to send a document to a server. In contrast, the provided system software of claim 12, in response to a request to remotely print the document and without user-initiated interaction with a server, generates a print file on the client based on the document, transmits the print file to the server in response to the generation of the print file, and prompts the user to configure

and preview a bound copy of the document using a browser in response to the transmission of the print file. In the method of claim 12, the user need not interact with a browser until the server has already received the print file from the system software. In contrast, both embodiments of Adamske and Tonkin contemplate the user using a browser (or alternatively attaching a file to an email message) to provide the server with a file that is used for configuring and/or previewing the document.

In light of the above, Appellants respectfully request reversal of the rejections of claim 12, and claims 13-16 and 32-34, which depend therefrom, as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske and Tonkin.

B. Claims 32 and 33

With further respect to claims 32 and 33, Appellants submit that the Examiner fails to show that the proposed combination of the two embodiments of Adamske and Tonkin teaches or suggests that the print file can be directly printed by a printer or that the print file comprises one of: a PostScript file and a Portable Document Format (PDF) file. In support of the rejection, the Examiner cites Adamske and alleges that "[t]he user then uploads the print file to the server, this print file (PostScript) being capable of being directly printed by a printer." Final Office Action, p. 5.

As discussed above, in a first embodiment, Adamske describes the user uploading an electronic document to a web server, which is routed to an application translation server for conversion to a portable printable format. Adamske, col. 5, lines 15-24. In the second embodiment, Adamske describes the user sending a "metafile to

translation server 24 through web server 22 and the conversion into a printable (e.g., PostScript) version is performed as previously described." Adamske, col. 6, lines 49-54. To this extent, neither embodiment of Adamske describes the user uploading a print file to a server. Furthermore, even if the proposed combination of Adamske and Tonkin teaches the user performing such an action, in claim 12, system software is provided, which generates and transmits the print file from the client to the server without user-initiated interaction with the server.

In light of the above, Appellants again respectfully request reversal of the rejections of claims 32 and 33 as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske and Tonkin.

C. Claim 13

With further respect to claim 13, Appellants submit that the Examiner fails to show that the proposed combination of Adamske and Tonkin teaches or suggests installing at least one print driver for generating the print file on the client as claimed therein. As discussed above, both embodiments of Adamske teach the generation of a print file on an application translation server (Adamske, col. 5, lines 21-24; col. 6, lines 50-52). The second embodiment generates the print file on the application translation server even when a print driver program is present on the client computer. Adamske, col. 6, lines34-38. The application translation server does not include any software that prompts the user to configure and preview a bound copy of the document using a browser as in claim 12. Additionally, the web server in Adamske does not provide a configuration wizard for display in a browser on the application translation server.

Furthermore, Tonkin fails to address these deficiencies of the embodiments of Adamske.

In light of the above, Appellants again respectfully request reversal of the rejections of claim 13 and claim 14, which depends therefrom, as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske and Tonkin.

D. Claim 14

With further respect to claim 14, Appellants respectfully submit that the Examiner fails to show that the proposed combination of the two embodiments of Adamske and Tonkin teaches or suggests generating the print file on the client using one of the at least one print driver in response to the request, and transmitting the print file to the server over the network in response to the generating as claimed therein. As discussed above, both embodiments of Adamske teach the generation of a print file on an application translation server (Adamske, col. 5, lines 21-24; col. 6, lines 50-52), even when a print driver program is present on the client computer (Adamske, col. 6, lines 34-38). The application translation server does not include any software that prompts the user to configure and preview a bound copy of the document using a browser as in claim 12. Additionally, the web server in Adamske does not provide a configuration wizard for display in a browser on the application translation server. Furthermore, Tonkin fails to address these deficiencies of the embodiments of Adamske.

In light of the above, Appellants again respectfully request reversal of the rejection of claim 14 as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske and Tonkin.

E. Claim 20

With respect to claim 20, for reasons that should be obvious in view of the discussion of the proposed combination of the two embodiments of Adamske and Tonkin above, Appellants respectfully submit that the proposed combination of the two embodiments of Adamske and Tonkin fails to teach or suggest a component configured to preview a document over a network by providing the system software claimed therein.

As a result, Appellants respectfully request reversal of the rejections of claim 20 and claims 21-23, which depend therefrom, as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske and Tonkin.

F. Claim 22

With further respect to claim 22, Appellants respectfully submit that the Examiner fails to show that the proposed combination of the two embodiments of Adamske and Tonkin teaches or suggests a local application that generates the document, displays the list of available printers and enables a user to select the print driver from the list of available printers as in claim 22. In support of the rejection, the Examiner alleges that "the claims incorporate substantially similar subject matter as claims 12-15." However, Appellants note that none of claims 12-15 claim a local application as in claim 22.

Additionally, only the second embodiment of Adamske discusses the use of a print driver program. However, the print driver program is only described as being "executable to convert the electronic document and provide the print preview capability prior to uploading to the web server." Adamske, col. 6, lines 34-38. To this extent, Adamske does not teach that the print driver program generates a print file, or is included as part of system software that communicates the print file to a server in response to the generation without user-initiated interaction with the server.

In light of the above, Appellants again respectfully request reversal of the rejection of claim 22 as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske and Tonkin.

G. Claim 24

With respect to claim 24, for reasons that should be obvious in view of the discussion of the proposed combination of the two embodiments of Adamske and Tonkin above, Appellants respectfully submit that the proposed combination of the two embodiments of Adamske and Tonkin fails to teach or suggest a component configured to print a document over a network by providing the system software claimed therein.

As a result, Appellants respectfully request reversal of the rejections of claim 24 and claims 25-27 and 35-36, which depend therefrom, as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske and Tonkin.

H. Claim 31

With respect to claim 31, for reasons that should be obvious in view of the discussion of the proposed combination of the two embodiments of Adamske and Tonkin above, Appellants respectfully submit that the proposed combination of the two embodiments of Adamske and Tonkin fails to teach or suggest program code for enabling a computer system to print a document by providing the system software claimed therein.

As a result, Appellants respectfully request reversal of the rejection of claim 31 as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske and Tonkin.

I. Claim 39

With respect to claim 39, Appellants incorporate the arguments presented above with respect to claim 37 from which this claim depends. Additionally, Appellants submit that the proposed combination of the two embodiments of Adamske with Tonkin fails to address the deficiencies of the proposed combination of the two embodiments of Adamske discussed above with respect to claim 37. As a result, Appellants respectfully request reversal of the rejection of claim 39 as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske and Tonkin.

J. Claim 42

With respect to claim 42, for reasons that should be obvious in view of the discussion of the proposed combination of the two embodiments of Adamske and

Tonkin above, Appellants respectfully submit that the proposed combination of the two embodiments of Adamske and Tonkin fails to teach or suggest a computer program product for enabling a computer system to preview a document by generating a print file on a client, transmitting the print file from the client to a server without user-initiated interaction with the server, and prompting the user to configure and preview a bound copy of the document as claimed therein.

As a result, Appellants respectfully request reversal of the rejection of claim 42 as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske and Tonkin.

IV.   Rejection of claim 43 under 35 U.S.C. § 103(a)

Furthermore, the Examiner rejects claim 43 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske in view of Tonkin further in view of Konica Minolta, "QMS Printing Notes for Windows Applications," published June 20, 1995 (KM). Appellants incorporate the arguments presented above with respect to claim 42 from which this claim depends. Additionally, Appellants submit that the proposed combination of the two embodiments of Adamske and Tonkin with KM fails to address the deficiencies of the proposed combination of the two embodiments of Adamske with Tonkin discussed above with respect to claim 42. As a result, Appellants respectfully request reversal of the rejection of claim 43.

V.   Conclusion

In summary, Appellants submit that independent claims 24, 32, and 36 are allowable over the cited art because the Examiner's use of Adamske, Tonkin, and/or Grohs fails to present a *prima facie* showing that each element of the claimed inventions is taught or suggested by the cited art. Additionally, Appellants respectfully submit that all other pending claims are allowable over the cited art by, *inter alia*, dependency.

Respectfully submitted,

/John LaBatt/

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Claim Listing:

12. A method of previewing a document over a network, the method comprising:

provifding system software for use on a client, wherein the system software allows a user of the client to use an application configured to at least one of: display or edit the document to request to remotely print the document, and, in response to the request and without user-initiated interaction with a server, generates a print file on the client based on the document, transmits the print file from the client to the server in response to the generation of the print file, and prompts the user to configure and preview a bound copy of the document using a browser in response to the transmission of the print file;

obtaining the print file from the system software executing on the client on the server; and

providing a configuration wizard for display in a browser on the client in response to a request from the client.

13. The method of claim 12, wherein the providing system software step includes installing at least one print driver for generating the print file on the client.

14. The method of claim 13, further comprising:

generating the print file on the client using one of the at least one print driver in response to the request;

transmitting the print file to the server over the network in response to the generating; and

prompting the user to configure and preview the bound copy of the document.

15. The method of claim 34, wherein the providing the preview step includes:

generating a configuration user interface on the server, wherein the configuration user interface includes:

a preview area for displaying the configured copy of the document; and

a printing option area for obtaining the configuration information; and

providing the configuration user interface for display at the client.

16. The method of claim 34, wherein the obtaining configuration information step includes:

obtaining a style and a printing option for printing the document;

modifying the preview based on the print file, the style and the printing option; and

providing the modified preview for display at the client.

20. A computer system comprising:

a component configured to preview a document over a network by performing a method comprising:

providing system software for use on a client, wherein the system software is configured to allow a user to request to remotely print the document, and, in

response to the request and without user-initiated interaction with a server, generate a print file on the client based on the document, transmit the print file from the client to the server in response to the generation of the print file, and prompt the user to configure and preview a bound copy of the document using a browser in response to the transmission of the print file, wherein the print file can be directly printed by a printer;

obtaining the print file from the system software executing on the client and configuration information for the document on the server, wherein the configuration information defines finishing and binding options for a printed copy of the document;

generating a preview of a configured copy of the document based on the print file and the configuration information on the server; and

providing the preview for display at the client.

21. The system of claim 20, wherein the system software includes:

a print driver that generates the print file, wherein the print driver is included on a list of available printers for the client; and

an upload manager that communicates the generated print file to the server.

22. The system of claim 21, further comprising a local application that generates the document, displays the list of available printers and enables a user to select the print driver from the list of available printers.

23. The system of claim 20, the method further comprising:

generating a configuration user interface on the server, wherein the configuration user interface includes a preview area for displaying the preview and a printing option area for selecting at least one printing option; and

providing the configuration user interface for display at the client.

24. A computer system comprising:

a component configured to print a document over a network by performing a method comprising:

providing system software for use on a client, wherein the system software is configured to enable a user of an application configured to at least one of: display or edit the document to request generation of a print file based on the document using the application, generate the print file on the client in response to the request without further user interaction, and transmit the print file from the client to a server in response to the generation of the print file without user-initiated interaction with the server;

obtaining a print file from the system software executing on the client and configuration information for the document on the server, wherein the print file can be directly printed by a printer and the configuration information defines how to assemble a printed copy of the document;

generating a preview of a configured copy of the document based on the print file and the configuration information on the server; and

providing the preview for display at the client.

25. The system of claim 35, the method further comprising:

    obtaining a delivery address for the copy; and

    providing the copy for delivery to the delivery address.

26. The system of claim 35, the method further comprising:

    obtaining payment information for the copy; and

    processing payment for the copy using the payment information.

27. The system of claim 24, wherein the system software includes:

    a print driver that generates the print file, wherein the print driver is included on a list of available printers for the client; and

    an upload manager that communicates the print file to the server.

31. A computer program product comprising a computer recordable medium having computer readable program code embodied therein for enabling a computer system to print a document by performing a method comprising:

    providing system software for use on a client, wherein the system software allows a user of the client to use an application configured to at least one of: display or edit the document to request to remotely print the document, and, in response to the request and without user-initiated interaction with a server, generates a print file on the client based on the document, transmits the print file from the client to the server in response to the generation of the print file, and prompts the user to configure and

preview a bound copy of the document using a browser in response to the transmission of the print file;

obtaining a print file from the system software executing on the client and configuration information communicated over a network, wherein the print file is based on the document and the print file can be directly printed by a printer and the configuration information defines how to assemble a printed copy of the document; and

printing a copy of the document based on the print file and the configuration information.

32. The method of claim 12, wherein the print file can be directly printed by a printer.

33. The method of claim 12, wherein the print file comprises one of: a PostScript file and a Portable Document Format (PDF) file.

34. The method of claim 12, further comprising:

obtaining configuration information for the document on the server from the configuration wizard, wherein the configuration information defines finishing and binding options for a printed copy of the document;

generating a preview of a configured copy of the document on the server based on the print file and the configuration information; and

providing the preview for display at the client.

35. The system of claim 24, the method further comprising:

      printing a copy of the document using the print file; and

      assembling the copy as defined by the configuration information.

36. The system of claim 24, wherein the system software is further configured to at least one of: prompt the user to configure and preview a bound copy of the document using a browser or launch the browser to configure and preview the bound copy of the document in response to the transmission of the print file.

37. A method of printing a document over a network, the method comprising:

      obtaining document information for a document on a server from system software executing on a client, wherein the system software is configured to enable a user of the client to use an application to request generation of a print file based on the document using the application, generate the print file on the client in response to the request without further user interaction, and initiate transmitting the print file from the client to the server in response to the generation of the print file and without user-initiated interaction with the server;

      generating a unique identifier for the document on the server and transmitting the unique identifier for use by the system software in response to obtaining the document information;

      obtaining the print file on the server from the system software executing on the client subsequent to obtaining the document information;

      storing the print file using the unique identifier;

obtaining a request for a configuration graphical user interface from the client subsequent to obtaining the print file; and

providing the configuration graphical user interface for display in a browser on the client in response to the request.

38. The method of claim 37, further comprising:

obtaining configuration information for the document on the server from the configuration graphical user interface, wherein the configuration information includes at least one printing option for the document and defines how to assemble a printed copy of the document;

printing a copy of the document based on the print file and the configuration information; and

assembling the copy of the document as defined by the configuration information.

39. The method of claim 38, wherein the obtaining configuration information includes:

generating a preview of a configured copy of the document on the server based on the print file and the configuration information, wherein the configuration graphical user interface includes a preview area for displaying the preview and a printing option area for obtaining a printing option;

providing the preview for display at the client;

obtaining the printing option for printing the document from the configuration graphical user interface at the server;

modifying the preview on the server based on the print file and the printing option; and

providing the modified preview for display at the client.

40. The method of claim 37, further comprising:

installing the system software on the client, wherein the system software includes at least one print driver for generating the print file on the client and an upload manager for communicating the print file from the client to the server;

generating the print file on the client using one of the at least one print driver on the client; and

transmitting the print file from the client over the network to the server using the upload manager.

41. A method of generating a graphical user interface comprising:

generating content for a display area of the graphical user interface, wherein the display area concurrently includes:

a preview area for displaying a preview of a configured copy of a document, wherein the preview is based on a print file and configuration information for the document, wherein the configuration information includes at least one printing option and defines how to assemble a printed copy of the document;

a navigation area that enables a user to select a portion of the configured copy of the document displayed in the preview area;

an estimate area for displaying a price estimate for printing and assembling the configured copy, wherein the price estimate is based on the print file and the configuration information; and

a configuration area that enables the user to alter the configuration information, wherein the preview area and the estimate area are automatically updated based on the altered configuration information.

42. A computer program product comprising a computer recordable storage medium having computer readable program code embodied therein for enabling a computer system to preview a document by performing a method comprising:

generating a print file on a client based on the document in response to a request received from an application, wherein the print file can be directly printed by a printer;

transmitting the print file from the client to a server in response to the generation of the print file without user-initiated interaction with the server; and

prompting the user to configure and preview a bound copy of the document using a browser in response to the transmission of the print file.

43. The computer program product of claim 42, the method further comprising installing the program code for generating and transmitting on the client, wherein the installing causes an entry to be added to a list of available printers for the client.

EVIDENCE APPENDIX

No evidence has been entered and relied upon in the appeal.

RELATED PROCEEDINGS APPENDIX

A copy of the decision on Appeal No. 2007-3345 for this application rendered by the Board on June 16, 2008 follows.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,433	11/13/2000	Jeff Stewart	MIME-0003	4323

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EXAMINER
CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFF STEWART and JENNIFER R. PINCO

Appeal 2007-3345
Application 09/709,433
Technology Center 2100

Decided: June 16, 2008

Before LANCE LEONARD BARRY, ALLEN R. MACDONALD, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the
Examiner's rejection of claims 12-33. Claims 1-11 have been cancelled
(App. Br. 2). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE INVENTION

The disclosed invention relates generally to a system, method and recordable medium for uploading data across a network. More particularly, Appellants' invention is directed to uploading a document across the network for printing services, and configuring, ordering, and viewing the document online (Spec. 1).

Independent claim 12 is illustrative:

> 12.   A method of previewing a document over a network, the method comprising:
>
>> providing system software for use on a client, wherein the system software allows a user of the client to generate a print file on the client based on the document using a local application;
>>
>> obtaining the print file from the client on a server;
>>
>> obtaining configuration information for the document on the server;
>>
>> generating a preview of a configured copy of the document on the server based on the print file and the configuration information; and
>>
>> providing the preview for display at the client.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejections:

Adamske	US 6,615,234 B1	Sep. 2, 2003
Bresnan	US 5,873,073	Feb. 16, 1999

THE REJECTIONS

Claims 12-27 and 29-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Adamske.

Claim 28 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Adamske in view of Bresnan.

PRINCIPLES OF LAW

Obviousness under 35 U.S.C. § 103

"What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under *§ 103*." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established functions." *Id.* at 1740. Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants' Briefs to show error in the proffered prima facie case.

Rationale for Modification of Adamske

The Examiner has rejected all but claim 28 under 35 U.S.C. § 103 using a single reference (Adamske). The Examiner proffers that an artisan

would have been motivated to combine or otherwise modify alternate
embodiments disclosed in Adamske, as follows:

> Adamske does not directly disclose in this embodiment that a
> preview is generated by the server and provided to the user
> based on the print file that was uploaded. However, Adamske
> discloses an alternate method in which the server generates a
> preview based on the print file and the configuration
> information and provides that preview to the user for display at
> the client device (column 5, line 64- column 7, line 15 of
> Adamske). It would have been obvious to one of ordinary skill
> in the art to combine the two methods of Adamske because it
> would have allowed the client system to do less work in the
> process.

(Ans. 3).

> In response, Appellants contend that the Examiner has improperly
relied upon hindsight, as follows:

> Adamske provides two embodiments for network-based
> document delivery. The Examiner primarily relies on the
> second embodiment in which the client performs some of the
> processing, e.g., generates a metafile and print preview.
> Adamske, col. 6, lines 24-57. The Examiner proposes to modify
> this embodiment with teachings of the first embodiment in
> which the client sends an electronic document to a server and
> displays a preview in a browser. Adamske, col. 4, line 6 1 -col.
> 6, line 23. The Examiner's motivation for the modifications is to
> "reduce the processing load at the client." Final Office Action,
> p. 12.
>   However, the first embodiment of Adamske (col. 4, line
> 61-col. 6, line 23) provides a solution in which the processing
> load at the client is reduced from that in the second
> embodiment. As a result, by its express teachings, Adamske has
> already addressed the motivation cited by the Examiner and
> teaches away from the Examiner's proposed modifications

> and Appellants' claimed invention. Since proper motivation is
> not found in Adamske, Appellants respectfully submit that the
> Examiner fails to show that Adamske or the prior art provides
> proper motivation for the modifications proposed by the
> Examiner without using the hindsight of the present invention.

(App. Br. 16-17).

After considering the record before us, it is our view that an artisan would have perceived the two embodiments relied on by the Examiner as being complements of each other. Courts should "take account of the inferences and creative steps that a person of ordinary skill in the art would employ." KSR, 127 S. Ct. at 1741. Therefore, it is our view that the teachings of Adamske would have at least suggested the claimed variation to an artisan having ordinary skill and creativity. Moreover, "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 127 S. Ct. at 1739).

This reasoning is applicable here. The Examiner has merely rearranged familiar elements taught by Adamske, such as a client, a server, and a print file having associated configuration information (e.g., fonts). It is our view that the Examiner's proffered combination of such familiar elements would have yielded predictable results. Appellants have not rebutted the Examiner's legal conclusion of obviousness by showing that the claimed combination of familiar elements produces any new function. Moreover, Appellants have not provided any factual evidence of secondary considerations, such as unexpected or unpredictable results, commercial success, or long felt but unmet need. Accordingly, we find Appellants'

arguments unpersuasive that the Examiner has relied upon impermissible
hindsight in modifying Adamske. We also note that Appellants do not
challenge the Examiner's proposed combination of Adamske and Bresnan
with respect to independent claim 28 (*see* App. Br. 20).

FINDINGS OF FACT

The following findings of fact (FF) are supported by at least a
preponderance of the evidence:

1. Adamske teaches that "web server 22 can include a print
   preview software program 16 . . . ." (Col. 6, ll. 4-5). Regarding
   Appellants' claimed "print file," Adamske teaches that
   "[a]pplication translation server 24 includes a conversion
   program 18 that is executable to read in the electronic document
   and convert the document to a portable printable format [print
   file]." (Col. 5, ll. 20-24). In one embodiment, Adamske teaches
   that the print file may be a PostScript format file. (Col. 5, ll.
   65-66). Regarding Appellants' claimed "configuration
   information," Adamske teaches that font database 31 (Fig. 2) is
   used to facilitate the conversion. (Col. 5, ll. 46-47). Adamske
   clearly uses font database 31 (i.e., configuration information) to
   generate the preview print file.

2. Adamske teaches a shipping label (i.e., memo information)
   (col. 7, l. 42). Adamske teaches that "[t]he hard copy document
   is . . . packaged according to the user preferences defined at
   operational screen 70 and delivered to the user-designated

recipient(s). Optionally, the print job that produces the hard copy document can also include a print out of the packaging instructions selected by the user, a cover sheet, and a shipping label (if applicable)." (Col. 7, ll. 37-43).

3. Adamske teaches a conversion program 18 (i.e., system software) (Col. 5, ll. 21-22). Adamske teaches that "[a]pplication translation server 24 includes a conversion program 18 [i.e., system software] that is executable to read in the electronic document and convert the document to a portable printable format." (Col. 5, ll. 21-24).

4. Adamske teaches that "[p]rint management server 28 will retrieve the converted printable (PostScript) electronic document and will send the document to the particular remote print spooler server 30 having the ID included at web server 22 via network 12. Network 12 can be the Internet or a private network connection for high traffic destinations such as an airborne courier. The print spooler server 30 prints the document at printer 40 attached locally to print spooler server 30." (Col. 7, ll. 27-35).

5. Adamske teaches a web browser (i.e., user interface) (Col. 5, l. 15).

ANALYSIS

After reviewing the record before us, we address arguments presented in the Briefs only to the extent that Appellant's arguments are directed to claimed subject matter. Patentability is based upon the claims. "It is the claims that measure the invention." *SRI Int'l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

We consider the following issues that flow from the contentions of the Appellants and the Examiner:

Independent claim 12

We disagree with Appellants' contention that Adamske fails to teach the claimed generation of a preview based on anything other than a converted printable electronic document (*see* App. Br. 8, ¶1). To the contrary, we find Adamske clearly uses font database 31 (i.e., configuration information) to generate the preview print file. Therefore, we find that Adamske teaches generating a preview of a configured copy of the document on the server based on the print file and the configuration information, as claimed (*see* FF 1, *supra*). Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner's rejection of independent claim 12 as being unpatentable over Adamske.

Independent claim 17

Appellants contend that Adamske fails to teach obtaining memo information that is customized for a recipient at each of a plurality of delivery addresses, let alone printing and delivering the customized memo along with the one or more copies of the document to each of the delivery addresses (App. Br. 9-10). In response, we broadly but reasonably construe the scope of the claimed "memo" as encompassing a shipping label that is customized according to the recipient's name and address and delivered with the print job, as taught by Adamske. See FF 2, *supra*. Therefore, we find that Adamske teaches obtaining memo information (i.e., a shipping label) that is customized for a recipient at each of a plurality of delivery addresses, and printing and delivering the customized memo along with the one or more copies of the document to each of the delivery addresses, as claimed. Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner's rejection of independent claim 17 as being unpatentable over Adamske.

Independent claim 20

Regarding independent claim 20, we have fully addressed the "generating" limitations in our discussion of independent claim 12 *supra*.

Appellants further argue that "[i]n both embodiments discussed in Adamske, a printable version of the electronic document is expressly generated on an application translation server (e.g., col. 5, lines 18-19, 64- 66 and col. 6, lines 49-52) rather than by system software on a client as in the claimed invention." (App. Br. 13).

In response, we broadly but reasonably construe a "client" as a requester of services and a "server" as a provider of services. To the extent that a client generates a print file and communicates the print file to a server, the client is providing a service (i.e., the print file) to the server. In this context, the client has become a server and the server has become a client. We restate our view that an artisan would have perceived the two embodiments disclosed by Adamske as being complements of each other. The person of ordinary skill is a person of creativity. Courts should "take account of the inferences and creative steps that a person of ordinary skill in the art would employ." KSR, 127 S. Ct. at 1741. Therefore, it is our view that the teachings of Adamske would have at least suggested the claimed variation to an artisan having ordinary skill and creativity.

Regarding the claimed "system software" element, we broadly but reasonably construe the scope of this term as encompassing any utility software associated with a computer system, noting that any program or utility can be included or associated with an operating system as a matter of design. Therefore, it is our view that Adamske's conversion program 18 teaches and/or suggests "system software," as claimed. See FF 3, *supra*. Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner's rejection of independent claim 20 as being unpatentable over Adamske.

Independent claim 24

We have fully addressed the "generating" limitations argued by Appellants in our discussion of independent claim 12 *supra*.

In our response for independent claim 20 we fully addressed Appellants contention that Adamske fails to teach or suggest means for obtaining a print file from a client. Again, it is our view that the teachings of Adamske would have at least suggested the claimed variation to an artisan having ordinary skill and creativity, as previously discussed.

Regarding Appellants contention that the Examiner fails to show that Adamske teaches or suggests the claimed means for assembling a copy based on configuration information, we broadly but reasonably construe the claim term "based on" as meaning "any association with." (*See* App. Br. 18). We note that Adamske's preview and printed copy both include fonts (i.e., configuration information). Therefore, it is our view that assembling a printed copy is reasonably "based on" fonts, because each printed page includes fonts.

Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner's rejection of independent claim 24 as being unpatentable over Adamske.

Independent claim 29

We have fully addressed the "generating" limitations argued by Appellants in our discussion of independent claim 12 *supra*.

In our response for independent claim 20 we fully addressed Appellants contention that Adamske fails to teach or suggest means for

obtaining a print file from a client. Again, it is our view that the teachings of Adamske would have at least suggested the claimed variation to an artisan having ordinary skill and creativity, as previously discussed.

Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner's rejection of independent claim 29 as being unpatentable over Adamske.

Independent claim 31

We have fully addressed the "memo" limitations in our discussion of independent claim 12 *supra*.

It is our view that Adamske teaches the claimed "program code for obtaining a print file and configuration information communicated over a network, wherein the print file is based on the document and the print file can be directly printed by a printer" (claim 31). See FF 4, *supra*.

Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner's rejection of independent claim 31 as being unpatentable over Adamske.

Independent claim 28

Regarding independent claim 28, we have fully addressed the "generating" limitations in our discussion of independent claim 12 *supra*. It is our view that Adamske teaches and/or suggests a user interface, as claimed. See FF 5, *supra*.

Regarding the Examiner's reliance on style options as teaching the claimed configuration information, it is our view that the claimed configuration information broadly but reasonably encompasses Adamske's fonts as contained in font database 31 (col. 5, ll. 47, Fig. 2). See FF1 and FF 4, *supra*. Clearly fonts can be altered (i.e., resized) using a "standard web browser," such as that disclosed by Adamske (col. 6, ll. 21-22). Therefore, we find that Adamske's web browser provides a user interface (i.e., configuration area) that enables the user to alter configuration information (i.e., fonts) in addition to previewing documents for printing (*see* Adamske, col. 6, ll. 20-22). See FF5, *supra*.

While our reading of Appellants' claims on the Adamske reference may have departed from some aspects of the Examiner's reading, it is our view that Appellants have been given full and fair notice of the Adamske reference and are responsible for all it discloses. *See In re Zenitz*, 333 F.2d 924, 926 (CCPA 1964) ("This court has held in a number of decisions that a United States patent speaks for all it discloses as of its filing date, even when used in combination with other references.")

Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner's rejection of independent claim 28 as being unpatentable over Adamske in view of Bresnan.

Dependent claims 13-16, 18, 19, 21-23, 25-27, 30, 32, and 33

These dependent claims were not separately argued in the Briefs. Therefore, we sustain the Examiner's rejection of these claims as being unpatentable over Adamske for the same reasons discussed *supra* with

respect to representative independent claims 12, 17, 20, 24, and 29,
respectively. *See* 37 C.F.R. § 41.37(c)(1)(vii).

<center>CONCLUSION OF LAW</center>

From the above discussion, we conclude that Appellant has not
sustained the requisite burden on appeal in providing arguments or evidence
persuasive of error in the Examiner's rejections. Section 103 within Title 35
of the U.S. Code "forbids issuance of a patent when 'the differences between
the subject matter sought to be patented and the prior art are such that the
subject matter as a whole would have been obvious at the time the invention
was made to a person having ordinary skill in the art to which said subject
matter pertains.'" *KSR*, 127 S. Ct. at 1734 (quoting 35 U.S.C. § 103).
Based on the findings of facts and analysis above, we conclude that
Appellants have not met their burden of showing that the Examiner erred in
rejecting claims 12-33 under 35 U.S.C. § 103(a) for obviousness.

DECISION

We affirm the Examiner's decision rejecting claims 12-33.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

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